



INTELLECTUAL PROPERTY
OFFICE OF THE PHILIPPINES

MADRID PROTOCOL

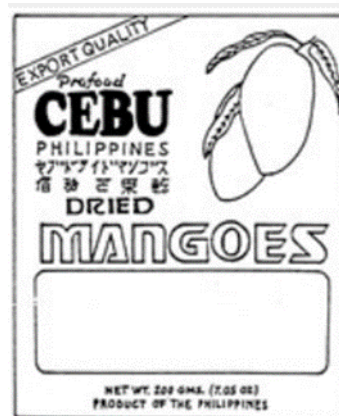
Protection of Brand in Export Markets

Valerie Laura V. Marquina

PH TRADEMARKS FILED UNDER THE MADRID SYSTEM



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MADRID PROCESS

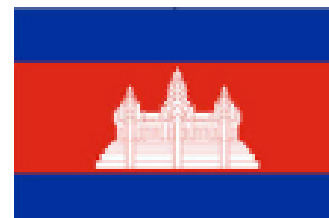
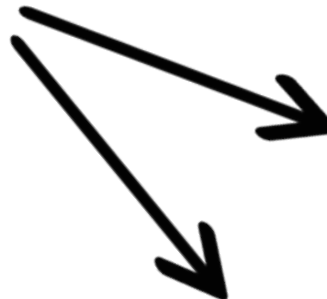
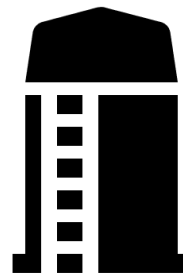
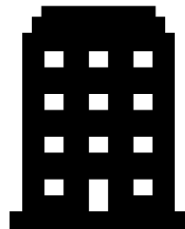


INTELLECTUAL PROPERTY
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Applicant submits the International Application **to the Office of Origin**

Office of Origin certifies the application form and **transmits** it to **WIPO**

International Bureau (IB) of WIPO conducts formality examination; registers in the International Register; publishes in the Gazette; issues Certificate of Registration; notifies the Designated contracting parties





INTELLECTUAL PROPERTY
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ROLES OF IP OFFICES

OFFICE OF ORIGIN



INTELLECTUAL PROPERTY
OFFICE OF THE PHILIPPINES

- Intellectual Property Office where the basic application or the basic registration **originates**
- where an application for international registration is **presented**

ROLES OF THE OFFICE OF ORIGIN



INTELLECTUAL PROPERTY
OFFICE OF THE PHILIPPINES

- Provides assistance to Trademark Owners and Applicants
- Receives the International Application (IA)
- Assesses and certifies the IA
- Transmits the IA to WIPO
- Remedies irregularities issued by WIPO
- Transmits to IB requests from holders for changes required to be sent thru the OO
- Monitors the basic mark
 - Notifies IB of Ceasing of Effect

WHAT ARE CERTIFIED?





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- **Date of receipt** of the application by the office of origin
- The **applicant** named in the international application is the **same** as the owner of the basic mark.
- The **mark** in the international application is the **same** as the basic mark.
- The **goods and/or services** listed in the international application are **covered** by the scope of the basic mark.
- Any **indications**, such as a claim to color as a distinctive feature of the mark, are the **same** as those contained in the basic mark.

SAMPLES



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	NATIONAL	INTERNATIONAL APPLICATION	CORRECT?
OWNER'S NAME	ABCC Corporation	ABC Corporation	✗
MARK			✗
GOODS/ SERVICES	1. Coffee, tea, cocoa, rice	1. Coffee, tea	✓
	2. Coffee, tea, cocoa, rice	2. Coffee, tea, cocoa, rice, pasta	✗
INDICATIONS	Color claim: Yellow	Color claim: Orange	✗



IRREGULARITIES



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- **Classification of goods and services**
- **Indication of goods and services**
- **Other irregularities (ex. Applicant's identity, entitlement, indication of contracting parties designated, etc.)**

CEASING OF EFFECT



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Protection may no longer be invoked if within 5 years the basic mark has been canceled, renounced, revoked, invalidated or has lapsed

Dependency Principle: the International Registration is dependent on the basic mark for a period of 5 years

OFFICE OF THE DESIGNATED CONTRACTING PARTY



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- Country party to the Madrid Protocol that is designated in the international application. *(PH Madrid Regulations)*
- Country where the filer wants his/her mark to be registered

ROLES OF THE DESIGNATED CONTRACTING PARTY (DCP)



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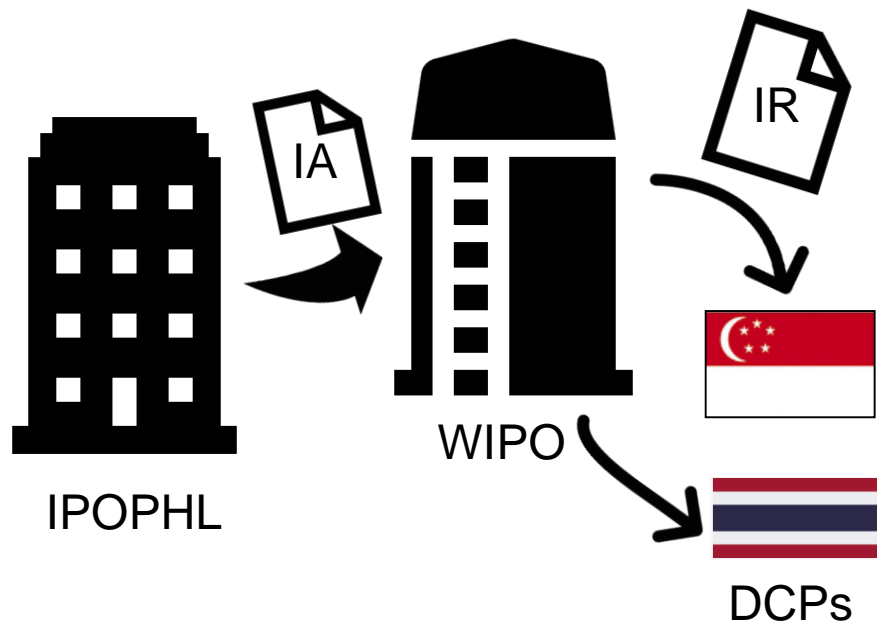
- **Substantive examination of International Registrations (IRs)**
 - **Issues Madrid Provisional Refusal of Protection (PRP) or Madrid Confirmation of Total PRP**
- **Sends Grant of Protection (GPs) to IB**
- **Sends Final or Further Decisions to IB**
- **Notifies IB of invalidations**
- **Amend the IRs for WIPO notifications received regarding a change of name of the holder, limitations or corrections**

OFFICE OF ORIGIN VS DESIGNATED CONTRACTING PARTY

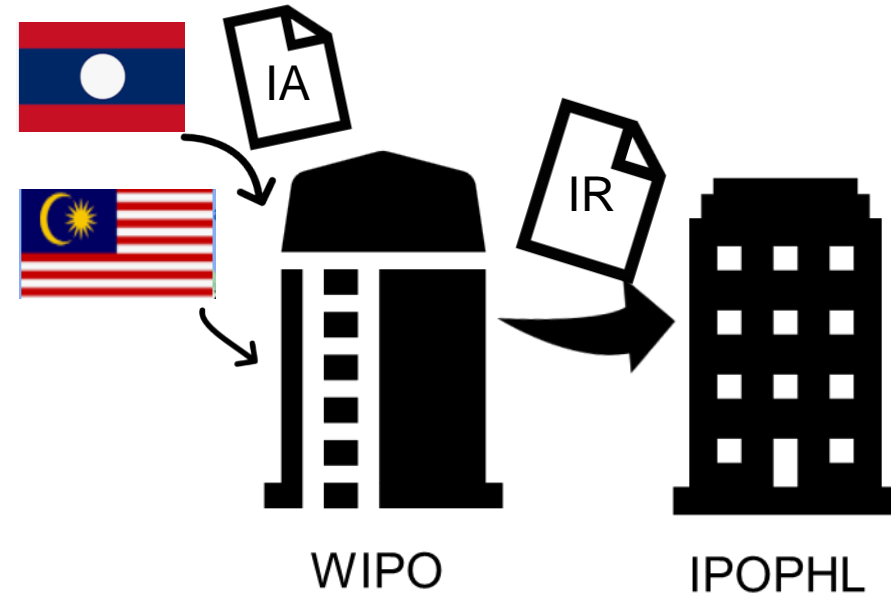


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PH as Office of Origin



PH as Designated Contracting Party





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TRADEMARK SEARCH

SEARCH TOOLS



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- ASEAN TMView
- TMView
- Global Brand Database
- IP Offices website
- WIPO Madrid System Member Profiles



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PREPARING AND FILING THE INTERNATIONAL APPLICATION

REQUIREMENTS



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- natural person or a legal entity, which has an entitlement or connection with a member of the Madrid System
- Basic mark – has an application or registration with the office of origin

ENTITLEMENT OR CONNECTION



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- Office of a country- the applicant is a national of that country or is domiciled or has a real and effective industrial or commercial establishment in that country
- Office of a contracting organization (like the EU)- the applicant is a national of a member State of that organization or, who is domiciled or, has a real and effective industrial or commercial establishment in the territory of that organization.

BASIC MARK



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- application or registration with the office of origin (local filing or registration)
- single mark or several marks

APPLICATION FORM (IA)



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- Madrid E-Filing, Madrid Application Assistant
- MM2 is presented to IB
 - Entries in the form must be typewritten

CONTENTS OF THE IA



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- Applicant's details
- Representative's details if any
- Entitlement to file
- Basic application or registration
- Priority Claim, if any
- Goods or services covered
- Mark
- Colors claimed, if any
- Designations
- Certification and signature by the office of origin
- Payment of application fees

DESIGNATIONS



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11. DESIGNATIONS¹⁴

Check the corresponding boxes:

<input type="checkbox"/> AE United Arab Emirates	<input type="checkbox"/> DZ Algeria	<input type="checkbox"/> KZ Kazakhstan	<input type="checkbox"/> RO Romania
<input type="checkbox"/> AF Afghanistan	<input type="checkbox"/> EE Estonia	<input type="checkbox"/> LA Lao People's Democratic Republic	<input type="checkbox"/> RS Serbia
<input type="checkbox"/> AG Antigua and Barbuda	<input type="checkbox"/> EG Egypt	<input type="checkbox"/> LI Liechtenstein	<input type="checkbox"/> RU Russian Federation
<input type="checkbox"/> AL Albania	<input type="checkbox"/> EM European Union ^a	<input type="checkbox"/> LR Liberia	<input type="checkbox"/> RW Rwanda
<input type="checkbox"/> AM Armenia	<input type="checkbox"/> ES Spain	<input type="checkbox"/> LS Lesotho ^b	<input type="checkbox"/> SD Sudan
<input type="checkbox"/> AT Austria	<input type="checkbox"/> FI Finland	<input type="checkbox"/> LT Lithuania	<input type="checkbox"/> SE Sweden
<input type="checkbox"/> AU Australia	<input type="checkbox"/> FR France	<input type="checkbox"/> LV Latvia	<input type="checkbox"/> SG Singapore ^b
<input type="checkbox"/> AZ Azerbaijan	<input type="checkbox"/> GB United Kingdom ^{b,j}	<input type="checkbox"/> MA Morocco	<input type="checkbox"/> SI Slovenia
<input type="checkbox"/> BA Bosnia and Herzegovina	<input type="checkbox"/> GE Georgia	<input type="checkbox"/> MC Monaco	<input type="checkbox"/> SK Slovakia
<input type="checkbox"/> BG Bulgaria	<input type="checkbox"/> GG Guernsey ^{b,k}	<input type="checkbox"/> MD Republic of Moldova	<input type="checkbox"/> SL Sierra Leone
<input type="checkbox"/> BH Bahrain	<input type="checkbox"/> GH Ghana	<input type="checkbox"/> ME Montenegro	<input type="checkbox"/> SM San Marino
<input type="checkbox"/> BN Brunei Darussalam ^b	<input type="checkbox"/> GM Gambia	<input type="checkbox"/> MG Madagascar	<input type="checkbox"/> ST Sao Tome and Principe
<input type="checkbox"/> BQ Bonaire, Saint Eustatius and Saba ^{f,g}	<input type="checkbox"/> GR Greece	<input type="checkbox"/> MK North Macedonia	<input type="checkbox"/> SX Sint Maarten (Dutch part) ^f
<input type="checkbox"/> BR Brazil ^{e,h}	<input type="checkbox"/> HR Croatia	<input type="checkbox"/> MN Mongolia	<input type="checkbox"/> SY Syrian Arab Republic
<input type="checkbox"/> BT Bhutan	<input type="checkbox"/> HU Hungary	<input type="checkbox"/> MW Malawi ^b	<input type="checkbox"/> SZ Eswatini
<input type="checkbox"/> BW Botswana	<input type="checkbox"/> ID Indonesia	<input type="checkbox"/> MX Mexico	<input type="checkbox"/> TH Thailand
<input type="checkbox"/> BX Benelux ⁱ	<input type="checkbox"/> IE Ireland ^b	<input type="checkbox"/> MY Malaysia ^b	<input type="checkbox"/> TJ Tajikistan
<input type="checkbox"/> BY Belarus	<input type="checkbox"/> IL Israel	<input type="checkbox"/> MZ Mozambique ^b	<input type="checkbox"/> TM Turkmenistan
<input type="checkbox"/> CA Canada	<input type="checkbox"/> IN India ^b	<input type="checkbox"/> NA Namibia	<input type="checkbox"/> TN Tunisia
<input type="checkbox"/> CH Switzerland	<input type="checkbox"/> IR Iran (Islamic Republic of)	<input type="checkbox"/> NO Norway	<input type="checkbox"/> TR Türkiye
<input type="checkbox"/> CL Chile	<input type="checkbox"/> IS Iceland	<input type="checkbox"/> NZ New Zealand ^b	<input type="checkbox"/> TT Trinidad and Tobago ^b
<input type="checkbox"/> CN China	<input type="checkbox"/> IT Italy	<input type="checkbox"/> OA African Intellectual Property Organization (OAPI) ^c	<input type="checkbox"/> UA Ukraine
<input type="checkbox"/> CO Colombia	<input type="checkbox"/> JM Jamaica	<input type="checkbox"/> OM Oman	<input type="checkbox"/> US United States of America ^d
<input type="checkbox"/> CU Cuba ^e	<input type="checkbox"/> JP Japan ^e	<input type="checkbox"/> PH Philippines	<input type="checkbox"/> UZ Uzbekistan
<input type="checkbox"/> CV Cabo Verde ^b	<input type="checkbox"/> KE Kenya	<input type="checkbox"/> PK Pakistan ^b	<input type="checkbox"/> VN Viet Nam
<input type="checkbox"/> CW Curaçao ^f	<input type="checkbox"/> KG Kyrgyzstan	<input type="checkbox"/> PL Poland	<input type="checkbox"/> WS Samoa
<input type="checkbox"/> CY Cyprus	<input type="checkbox"/> KH Cambodia	<input type="checkbox"/> PT Portugal	<input type="checkbox"/> ZM Zambia
<input type="checkbox"/> CZ Czech Republic	<input type="checkbox"/> KP Democratic People's Republic of Korea		<input type="checkbox"/> ZW Zimbabwe
	<input type="checkbox"/> KR Republic of Korea		



SECOND LANGUAGE



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If the **European Union** is designated, it is compulsory to indicate a second language before the Office of the European Union, among the following (check one box only):

☐

French

☐

German

☐

Italian

☐

Spanish



To be annexed to each international application or subsequent designation in which the United States of America is a designated Contracting Party¹.

DECLARATION OF INTENTION TO USE THE MARK: UNITED STATES OF AMERICA

By designating the United States in the international application/subsequent designation, the person signing below declares that:

- (1) the applicant/holder has a *bona fide* intention to use the mark in commerce that the United States Congress can regulate on or in connection with the goods/services identified in the international application/subsequent designation;
- (2) he/she is properly authorized to execute this declaration on behalf of the applicant/holder;
- (3) he/she believes applicant/holder to be entitled to use the mark in commerce that the United States Congress can regulate on or in connection with the goods/services identified in the international application/subsequent designation; and
- (4) to the best of his/her knowledge and belief no other person, firm, corporation, association, or other legal entity has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive;
- (5) to the best of the signatory's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances, the allegations and other factual contentions made above have evidentiary support.

I declare under penalty of perjury under the laws of the United States of America that all the foregoing statements are true and correct to the best of my knowledge and belief. I understand that willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, and are punishable by fine or imprisonment, or both (18 U.S.C. §1001). 35 U.S.C. §25(b).

Signature

Date of execution
(dd/mm/yyyy)

Signatory's Name (Printed)

Signatory's Title

¹ This form contains the **exact wording** of the declaration of intention to use the mark required by the United States of America. It should not be amended in any respect. Deletions, modifications or inclusions of text will result in the declaration being considered as **Irregular**. The United States of America requires that the declaration of intention to use the mark be made in English, even if the international application or the subsequent designation is in French or Spanish. Therefore, this form is available in **English only**.

INSTRUCTION

This declaration must be signed by:

- (1) the applicant/holder or a person with legal authority to bind the applicant/holder; or
- (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the applicant/holder; or
- (3) an attorney who is authorized to practice before the United States Patent and Trademark Office under 37 C.F.R. §10.1(c), who has an actual written or verbal power of attorney or an implied power of attorney from the applicant/holder.

INFORMATION REQUIRED BY THE INTERNATIONAL BUREAU

- (a) Where the present declaration refers to an international application based on a basic application, indicate:

Basic application number: Date of the basic application (dd/mm/yyyy):

- (b) Where the present declaration refers to an international application based on a basic registration, indicate:

Basic registration number: Date of the basic registration (dd/mm/yyyy):

- (c) Where the present declaration refers to a subsequent designation of an international registration, indicate:

International registration number:

International Bureau's reference (where applicable):

Name of applicant/holder:



PAYMENT OF FEES



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FEES PAYABLE FOR AN IA:

Basic Fee: <ul style="list-style-type: none">• Black and white• With color/s	CHF 653 CHF 903
Complementary fee <ul style="list-style-type: none">• for each designated member in respect of which no individual fee is payable	CHF 100
Supplementary fee <ul style="list-style-type: none">• for each class of goods and services in excess of three;• where, however, all the members designated are those in respect of which an individual fee is payable, no supplementary fee is required.	CHF 100
Individual fee <ul style="list-style-type: none">• for the designation of each member that has made the relevant declaration	

HOW TO PAY THE FEES



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- **Debiting the amount from a Current Account with WIPO**
- **from funds already transferred to WIPO**
- **transferring the required fees into WIPO's postal account (within Europe only) or bank account**
- **credit card if:**
 - **Office of origin has used Madrid E-Filing**
 - **Applicant used Madrid Application Assistant**
 - **With an Irregularity notice concerning fees**

HOW TO PAY THE FEES



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- Responsibility of the applicant
- Some offices collect and forward the fees to IB for the applicant
- PH:
 - IPOPHL: handling fee only
 - PH local banks: for the different designated countries due to IB



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MANAGING THE INTERNATIONAL REGISTRATION

-
- **Monitor your registration**
 - **Madrid Monitor – Real-time search**
 - **Expand protection – Subsequent Designation**
 - **Limit the goods and services – restriction of the goods and services for some of the members designated**
 - **Renounce the protection – abandon the effects for some but not all the designated members**



-
- **Manage the representative**
 - **Change holder's details**
 - **Change ownership**
 - **Renew registration**

MAINTENANCE OF REGISTRATION



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- **Know the maintenance requirements of the designated contracting parties**
 - **WIPO Madrid Member Profiles Database**
 - **For ex. PH: Declaration of Actual Use (DAU)**



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*File your mark
now and go
GLOBAL!*

Thank You!



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Intellectual Property Center
#28 Upper McKinley Road
McKinley Hill Town Center
Fort Bonifacio, Taguig City
Philippines



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